

REMARKS

Claims 1, 2, and 4 are pending. All claims are under examination. No claim is withdrawn.

Support

Support for the amendments to claim 1 can be found in original claim 3, which has now been canceled.

Issues under 35 UCS 102

The rejection of claims 1, 2, and 4 in paragraph 3 on page 2 of the last Office Action as anticipated under 35 UCS 102 by any one of the twenty-two (22) cited references is traversed, but has been rendered moot by the present amendments.

As presently amended all claims are limited to the defined emulsion wherein "Y" of the organopolysiloxane of formula (I) is an SH group and R⁶ of the monomer of Formula (II) is a certain alkoxy-substituted alkyl group. It is respectfully submitted that none of the prior art discloses or suggests the claimed composition having this combination.

The rejection under 35 UCS 102 has also been rendered moot by limiting all claims to the glass transition temperature of claim 3.

Issues under 35 UCS 103

The rejection of claim 3 in paragraphs 4 and 5 on page 3 of the last Office Action as being anticipated under 35 USC 102 obvious under 35 USC 103 is traversed, but has been rendered moot by the cancellation of this claim. The Examiner has not provided a “sound basis”, i.e., scientific reasoning, to explain why a particular prior art product would have the claimed properties. Therefore, a rejection based on 35 USC 102 is not proper, MPEP § 2112.01I. Even assuming, for the sake of argument, that the invention of claim 3 is “within the generic disclosure of the prior art” as suggested by the Examiner, this is not sufficient to create a *prima facie* case of obviousness. The Examiner has not combined the references, but instead, has rejected the claims over a number of references individually. Even if they are considered in combination, there is no motivation for the combination.

According to MPEP § 2144.08, II., A, unless the Examiner explains why one skilled in the art would be motivated to make the claimed invention, a *prima facie* case of obviousness is not established over a single prior art reference, which might generically encompass the claimed improvement.

In view of the above amendments, applicants believe the pending application is in condition for allowance.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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